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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,787	07/05/2001	David Paul Felsher	FELSHER 201.1	2368
10037	7590	03/09/2005	EXAMINER	
MILDE & HOFFBERG, LLP 10 BANK STREET SUITE 460 WHITE PLAINS, NY 10606			SHERR, CRISTINA O	
		ART UNIT	PAPER NUMBER	
		3621		

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/899,787	FELSHER, DAVID PAUL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 December 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-144 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-144 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

1. This communication is in response to the applicant's amendment filed December 22, 2004. Claims 1, 2, 4, 6, 7, 17, 18, 25, 26, 27, 28, 31, 33, 36, 37, 38, 39, 45, 46, 47, 50, 52, 53, 58, 59, 63, 64, 69, 72, 74, 82, 83, 93, 94, 102, 103, 110, 111, 112, 113, 114, 116, 120, 121, 123, 124, 127, 128, 129, 130, 131, 132, 133, 34 137, 140, 142. Claim 144 has been newly added. Claims 1-144 are pending in this case.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-143 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. Claims 140 and 141 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although claim 140 has been amended, it still, in its amended form, does not meet the 101 test laid out below. Although, apparently an agreement was reached with respect to this claim via telephone interview, examiner mistakenly understood that the amendment to reference cryptography, and therefore technology, had been made to claim 140 (the independent claim) rather than to claim 141 (the dependent claim). As claim 140 stands, the rejection is maintained.

4. Further, claims 1, 39, and 53 as amended, and therefore their dependent claims 2-38, 30-52, and 54-57 are now also rejected under section 101, for the same reasons outlined below.

5. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

6. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

7. In the present case, claim 140 is directed at a business method, comprising the steps of: establishing, in an organization distinct from the caregiver, a medical information trust to hold a medical record or associated access permission on behalf of a patient; charging for access to or permission to access the medical record; and maintaining a record of each access of or permission to access the medical record. Nothing in the language of the claim indicates any relation with the technological arts. The method of this claim could be carried out easily with handwritten records kept in a trunk in the back room of a medical office.

8. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. Even though claim 141 indicates the use of cryptology, such use is not enough to render claim 140 within the technological arts.

9. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Clearly these claims do yield a useful, concrete and tangible result, that of holding medical records in confidence such that they are not revealed except to those people for the better treatment of the patient. However, since claims 1, 39, 53, and 140 meet only the one of the two prongs, they are rejected under 35 U.S.C. 101, as are their dependent claims 2-38, 40-52, 54-57 and 141.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 96-126, 142-143 and 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,021,202).

12. Regarding claims 96, 142 and 144 –

Anderson discloses a method, comprising the steps of: receiving a record; referencing a set of access rules for the record; and applying an appropriate set of access rules to limit access to the record, the limitations being enforced one or more selected from the group consisting of a cryptographic method for selectively limiting record access based on possession of a cryptographic key, and a trustee applying the access rules to limit access to the record (e.g. col 10 ln 35 – col 12 ln 10).

13. Regarding claims 97-126 and 143 –

Anderson discloses a method according to claim 1, further comprising the step of accounting for a decryption of the record, wherein said accounting is anonymous, wherein the record has a plurality of portions, each portion being encrypted with at least one cryptographic key, said portions being independently accessible, said access rules applying to selectively limit access to portions of the record, said access rules limit access to portions based on an identity of an intended recipient, supplying a decryption key for a respective record portion in accordance with the applied set of rules, comprising the step of accounting for a decryption of a portion of the record, wherein the set of access rules are associated with an intended recipient of the record, referencing an index to define a record, wherein the index further stores a set of access rules for qualifying an intended recipient with respect to each of the records, using an index to identify a record potentially responsive to a query, using an index comprising a set of associations of patient identities and medical transaction records to identify records relating to a respective patient, wherein the record comprises a plurality of portions, the portions being separately encrypted and having associated sets of independent rules, 1, wherein the access rules are role based access rules relating to a role of the intended recipient, wherein the remotely sensed transaction comprises a financial accounting transaction, wherein the remotely sensed transaction comprises an access audit trail transaction, wherein said accounting occurs upon supply of the respective decryption key, wherein the record comprises a medical record, wherein the access rules comprise a database of jurisdictional trust laws (e.g. col 11 ln 65 – col 12 ln 55).

14. Although Anderson does not specifically state a trust document, the difference in documents is merely in non-functional data.

15. Claims 58-95, and 127-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,021,202).

16. Regarding claim 58 and 127 –

Anderson discloses a method, comprising the steps of: placing information in trust with a trustee on behalf of a beneficiary; permitting a user to access the information in the trust; and implementing a rule for selectively providing access to the information in trust, including requiring an electronic communication between the user and the trustee, comprising a plurality of records, each record having an associated set of access rules, means for applying the appropriate set of access rules to limit access to the record, the limitations being enforced by one or more selected from the group consisting of a cryptographic method for selectively limiting record access based on possession of a cryptographic key and a trustee applying the access rules on behalf of a beneficiary, including patient-specific data, comprising at least one medical transaction information file, associated with the specific patient, each medical transaction information file being separately encrypted (e.g. col 10 ln 35 – col 12 ln 10).

16. Regarding claims 59-95, and 128-139 –

Anderson discloses a method, apparatus and system wherein the rule comprises a compensation rule for obtaining a right to the information, the electronic communication comprises an electronic funds transfer, wherein the compensation rule is integrally associated with the information, and wherein the implementing occurs as a result of

user interaction with the information, wherein the information comprises a patient medical record, wherein the information comprises consumer entertainment media, wherein the trustee is interposed between a rights holder for the information and the user, the trustee maintaining an anonymity of the user while accounting to the rights holder, wherein the trustee is interposed between a rights holder for the information and the user, the trustee characterizing the user based on a classification of information usage, while accounting to the rights holder for the use, without specifically identifying information usage of a user, wherein a transfer of the information to the user requires an electronic transfer of value from the user to the trustee, further comprising the accepting the value by the trustee while stripping a retained transfer record of an identifier of the user, receiving an identification of desired information content from a user; and logging the access employing a digital signature of the user, wherein the digital signature is anonymous with respect to the beneficiary, wherein the permitting the access entails requiring the user to enter into a restrictive covenant, wherein the trustee manages access to the information and implements the access rules as an intermediary for, and communicates compensation information to, the beneficiary, and wherein the information has an associated compensation value, and comprises digital media information, said digital media information being associated with subsidy content, further comprising the step of accounting with the user for use of the digital media information offset by a value for subsidy content (e.g. col 11 ln 65 – col 12 ln 55).

17. Although Anderson does not specifically state a trust document, the difference in documents is merely in non-functional data.

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18 Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Cordery et al (US 6,134,328A discloses a secure user certification for electronic commerce employing value metering system.

21. Ginter et al (US 6,640,304B1) discloses systems and methods for secure transaction management and electronic rights protection.

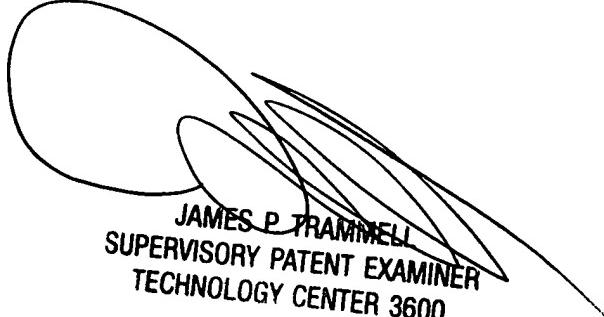
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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